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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,526	01/29/2001	Otto Dobrounig	ADI-020CN	9695

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EXAMINER

WONG, STEVEN B

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 05/20/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/771,526

Applicant(s)

DOBROUNIG, OTTO

Examiner

Steven Wong

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-12 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-12 and 24-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-12 and 24-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to set forth that the spherical bodies within the matrix material are resilient. Page 7, lines 10-21 of the specification describe the properties of the microspheres, however, they fail to disclose that the spherical bodies are, in fact, resilient. The specification does state that the microspheres are hollow in nature and it would appear that this property is what applicant relies upon for giving the microspheres their resiliency, however the specification does not specially define the microspheres as being resilient.

***Claim Rejections - 35 USC § 102***

4. Claims 1, 3-7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Aoyama (5,688,192). Regarding claim 1, Aoyama discloses a golf ball construction comprising an outer

skin (5) having a plurality of resilient spherical bodies in a matrix material. Note column 3, lines 2-5 and column 3, line 62 through column 4, line 5.

Regarding claims 3-7, Aoyama provides acrylonitrile copolymer microspheres in a polyurethane matrix and an outer skin (3).

Regarding claims 11, the polyurethane is seen as an adhesive material.

***Claim Rejections - 35 USC § 103***

5. Claims 1, 3, 4, 6, 7, 9-12 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/09034 (Mills) in view of Delacoste. Regarding claim 1, Mills discloses a soccer ball construction including an inflatable core (1) and an outer skin (13) formed from a plurality of cut pieces.

Delacoste reveals a soccer ball construction including an outer skin including a syntactic material (note column 3, lines 45-62). It would have been obvious to one of ordinary skill in the art to include a syntactic material in the ball construction of Mills in order to construct a soccer ball having physical properties substantially akin to those of conventional leather balls. Further, note column 4, lines 9-13 of Delacoste stating that hollow spheres may be used in the matrix material.

Regarding claims 3, 4, 6 and 11, Delacoste teaches dispersing polymeric hollow microspheres within polyurethane material.

Regarding claims 7, 9 and 10, Mills teaches an internal layer (12) for the ball formed of fibre cloth.

Regarding claim 12, Mills provides a middle skin and a backing layer (12) and an inflatable bladder layer (11).

Regarding claims 24 and 25, Mills teaches for the layers to be bonded together. Mills also states that the ball may be hand-sewn together.

Regarding claims 26 and 27, it would have been obvious to one of ordinary skill in the art to provide the microspheres of Delacoste in the recited amount as the applicant has not shown the criticality for the recited amount and it appears that the amounts taught by Delacoste would accomplish similar purposes.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/09034 (Mills) in view of Delacoste and Aoyama (5,688,192). Aoyama teaches a plurality of acrylonitrile copolymer microspheres within a polyurethane matrix material. It would have been obvious to utilize microspheres formed from acrylonitrile copolymer in order to take advantage of that material's particular physical characteristics.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/09034 (Mills) in view of Delacoste and Kennedy et al. (5,091,265). Kennedy et al. disclose a ball construction including an outer layer formed from an aliphatic material (note column 4, lines 17-25). It would have been obvious to one of ordinary skill in the art to utilize an aliphatic material in the ball composition of Mills in order to take advantage of that materials' physical characteristics.

8. Claims 9, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama (5,688,192). It would have been obvious to one of ordinary skill in the art to provide an

Art Unit: 3711

additional layer to the ball of Aoyama in order to further enhance the playing characteristics of the ball.

Regarding claims 26 and 27, it would have been obvious to one of ordinary skill in the art to provide the microspheres of Aoyama in the recited amount as the applicant has not shown the criticality for the recited amount and it appears that the amounts taught by Aoyama would accomplish similar purposes.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama (5,688,192) in view of Kennedy et al. (5,091,265). It would have been obvious to one of ordinary skill in the art to utilize an aliphatic material in the ball composition of Aoyama in order to take advantage of that materials' physical characteristics.

### *Response to Arguments*

Applicant's arguments filed March 10, 2003 have been fully considered but are not deemed to be persuasive. Regarding applicant's argument that the combination of Mills in view of Delacoste lacks the teaching for resilient spherical bodies, attention is first directed to the rejection under 35 USC 112. The limitation for the spherical bodies to be resilient is not sufficiently described in the originally filed specification. Secondly, the reference to Delacoste specifically teaches both solid and hollow microspheres for altering the rebound characteristics. Although hollow glass microspheres may not possess the same amount of resiliency as applicant's acrylonitrile copolymer microspheres, claim 1 fails to define either the material or the amount of physical resiliency. Applicant's statement that Delacoste provides "rigid" microspheres is without merit as nowhere in the specification of Delacoste are the hollow

Art Unit: 3711

microspheres described as being rigid. Indeed, much like applicant's originally filed specification lacks any statement that the microspheres are resilient, the specification of Delacoste lacks any statement that his microspheres are rigid.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Regarding the applicant's arguments directed to the Okumoto et al. reference, such remarks are deemed to be moot in view of the new grounds of rejection involving the reference to Aoyama.

Regarding the applicant's arguments directed to the Kennedy et al. reference, this reference is cited merely for its teaching that it is well known in the art of game balls to provide an aliphatic material in order to take advantage of its well known physical characteristics.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

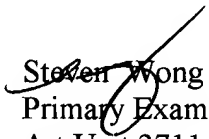
Art Unit: 3711

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 703-308-3135. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

  
Steven Wong  
Primary Examiner  
Art Unit 3711

SBW  
May 14, 2003